

Appl. No. 10/824,844
Reply to Office Action of May 17, 2006

Attorney Docket No. 35271.34
Customer No. 27683

REMARKS

Claims 1-4, 6-14 and 16-85 are pending in the application. In view of the remarks that follow, Applicants respectfully request reconsideration.

Allowed Claims

Noted with appreciation is the indication in the Office Action that Claims 1-37 and 50-85 have been allowed. (As a practical matter, since Claims 5 and 15 were previously canceled, the allowed claims are actually Claims 1-4, 6-14, 17-37 and 50-85).

Comment Regarding Error in Published Application

The present application was published on December 30, 2004 as U.S. Patent Application Publication No. 2004/0263329. Applicants have noted that this publication includes a printing error. In particular, line 15 in paragraph [0026] of the publication contains the word "comers". However, this word should actually be "corners", as evident from line 10 in paragraph [0026] of the present application as originally filed. Applicants wish to ensure that this printing error is not repeated in the patent that will eventually issue from this application. Since this error is not present in the specification filed in the present application, it cannot properly be corrected by amending the specification of the present application. This error has crept into some electronic document that the PTO used to publish this application, and that the PTO will eventually use to publish the printed patent. Applicants therefore respectfully request that the Examiner take the steps needed to correct this PTO error in the separate document that is being used as a basis for publications, in order to bring that separate document into conformity with the currently-pending specification of the present application.

Comment Regarding Claims 38-39 and 41-43

The Office Action indicates that Claims 38-39 and 41-43 are rejected under 35 U.S.C. §103 as obvious, "for the reasons of record as discussed in the previous Office action".

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However, in the previous Office Action, Claims 38-39 and 41-43 were all rejected under §102, not §103. If the present Office Action did in fact intend to reject these claims under §103, then Applicants respectfully object to the §103 rejection as defective, because neither the present Office Action nor the previous Office Action properly establishes a prima facie case of obviousness under §103 in the manner required by MPEP §2142 and MPEP §706.02(j). Further, if the rejection is under §103, Applicants traverse the finality of the Office Action, because rejection of these claims under §103 would be a new ground of rejection that cannot properly be presented for the first time in a final rejection. For purposes of this Response, it is assumed that the rejection of Claims 38-39 and 41-43 is under §102 rather than §103, in particular as set forth in the previous Office Action.

Comment Regarding Claim 44

The Office Action also indicates that Claim 44 is rejected under 35 U.S.C. §103 as obvious, "for the reasons of record as discussed in the previous Office action". However, the previous Office Action did not set forth any rejection of Claim 44 in view of the prior art, under either 35 U.S.C. §102 or §103. And since the previous Office Action did not set forth a rejection of Claim 44, the present Office Action does not properly set forth any ground of rejection of Claim 44 by attempting to refer to a rejection that did not actually appear in the previous Office Action. Since there is no proper rejection of Claim 44 in either Office Action, under either §102 or §103, it is respectfully submitted that Claim 44 is an allowable claim, and notice to that effect is respectfully requested.

Comment Regarding the Repeated Claim Rejections

The provisions of MPEP §707.07(f) instruct examiners that:

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Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In the present Office Action, the Examiner repeats certain claim rejections that were imposed in the previous Office Action, but completely fails to comply with this MPEP requirement. The Examiner merely states that "Applicant's arguments filed 3/20/2006 have been fully considered but they are not persuasive". This statement does not recognize or answer the substance of any of Applicants' prior arguments. It is therefore respectfully submitted that the present Office Action is not complete, because it fails to comply with the PTO requirement set forth in MPEP §707.07(f). Consequently, it is respectfully submitted that the present Office Action must be withdrawn, and replaced with a new and complete Office Action that does comply with MPEP 707.07(f).

Independent Claim 38

The present Office Action indicates that independent Claim 38 is rejected for the same reason set forth in the previous Office Action, where Claim 38 was rejected under 35 U.S.C. §102 as anticipated by Breed U.S. Patent No. 6,919,803. This ground of rejection is respectfully traversed, for the following reasons. Claim 38 recites:

A method comprising:
monitoring whether a door of a container is in a closed position; and
emitting a wireless signal indicating whether said container door is in said closed position.

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The §102 rejection of Claim 38 asserts that Breed has a door status sensor 24, and that Breed uses the sensor 24 to detect whether a container door is currently in its closed position. However, this is not what Breed actually teaches. In particular, and contrary to the assertions in the rejection, Breed's sensor 24 is not configured to detect whether a door is currently closed. Instead, Breed's sensor 24 is configured to detect the point in time at which a door first reaches a closed position after having been open, or in other words is configured to detect a specific sequence of both the open position and the closed position. For example, lines 27-29 in column 11 of Breed explain that the sensor 24 detects when a door is "closed after having been opened". Similarly, lines 38-39 in column 11 indicate that the sensor 24 detects "an opening and subsequent closing of the door". As still another example, lines 41-46 in column 11 state that the sensor 24 detects "when at least one door is closed after having been opened". MPEP §2131 specifies that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element recited in the claim. As evident from the foregoing discussion, Breed does not disclose each and every element that is recited in Claim 38. Accordingly, Breed does not anticipate Claim 38 under §102. Claim 38 is thus believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claim 48

The Office Action rejects Claim 48 under 35 U.S.C. §103 as obvious in view of Breed. Applicants respectfully traverse this ground of rejection, for different reasons that are discussed separately below.

First, it is respectfully submitted that the §103 rejection is not complete, because it fails to comply with the PTO's requirements for a §103 rejection. More specifically, MPEP §706.02(j) explains that, in order to establish a prima facie case of obviousness under 35 U.S.C. §103, an examiner must satisfy every one of four specific requirements. In particular, MPEP §706.02(j) specifies that:

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35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The §103 rejection of Claim 48 is presented for the first time in the present Office Action, and fails to comply with any of the four requirements listed above. Instead, the Examiner simply makes a conclusory assertion that the subject matter of Claim 48 would be obvious, and refers to a previous rejection of Claims 38-46. However, as discussed above, most of Claims 38-46 were rejected under §102 and not §103, and in any event none of Claims 38-46 recite the same subject matter as Claim 48. Since the §103 rejection of Claim 48 thus does not comply with any of the requirements for a proper §103 rejection, it is respectfully submitted that it is defective and must be withdrawn.

For completeness, Applicants will briefly explain why Claim 48 is not obvious in view of Breed. (However, this is not a waiver of Applicants' objection to the fact that the §103 rejection of Claim 48 is defective). Claim 48 depends from Claim 38, and includes a recitation of "emitting said wireless signal at a location external to said container". In regard to Claim 48, the

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Office Action cites a sentence at lines 41-46 in column 11 of Breed. This sentence in Breed states that:

The door status sensor 24 is coupled to the interior sensor system 12, or at least to the transmitters 14,14' so that the transmitters 14,14' can be designed to transmit waves into the interior of the container 10 only when the door status sensor 24 detects when at least one door 18 is closed after having been opened. (Emphasis added).

Contrary to the assertions in the Office Action, the indicated sentence of Breed does not contain anything that even remotely says Breed emits a wireless signal at a location external to the container. MPEP §2142 states with respect to §103 that to "establish a *prima facie* case of obviousness . . . the prior art reference . . . must teach or suggest all the claim limitations". (Emphasis added). Breed fails to satisfy this PTO requirement, because Breed does not teach or suggest all the claim limitations. Therefore, it is respectfully submitted that Claim 48 is not obvious under §103 in view of Breed, and notice to that effect is respectfully requested.

Independent Claim 42

The present Office Action indicates that independent Claim 42 is rejected for the same reason set forth in the previous Office Action, where Claim 42 was rejected under 35 U.S.C. §102 as anticipated by Breed. This ground of rejection is respectfully traversed, for the following reasons. Claim 42 recites:

An apparatus comprising: . . .
a first portion which monitors whether said door of said
container is in said closed position; and

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a second portion which is cooperable with said first portion
and which can emit a wireless signal indicating whether said
container door is in said closed position.

The rationale given for the rejection of Claim 42 is the same basic rationale given for the rejection of Claim 38. However, as discussed above in association with Claim 38, Breed's sensor 24 does not specifically detect that a door is currently in a closed position. Instead, the sensor is configured to detect a situation where a door has just reached a closed position after having been open, or in other words is configured to detect a specific sequence of both the open position and the closed position. As noted earlier, MPEP §2131 specifies that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element that is recited in the claim. As evident from the foregoing discussion, Breed does not disclose each and every element that is recited in Claim 42. Accordingly, Breed does not anticipate Claim 42 under §102. Claim 42 is thus believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claim 49

The Office Action rejects Claim 49 under 35 U.S.C. §103 as obvious in view of Breed. Applicants respectfully traverse this ground of rejection, for different reasons that are discussed separately below.

First, it is respectfully submitted that the §103 rejection is not complete, because it fails to comply with the PTO's requirements for every §103 rejection. More specifically, as discussed above, MPEP §706.02(j) explains that, in order to establish a prima facie case of obviousness under 35 U.S.C. §103, an examiner must satisfy every one of four specific requirements. In particular, MPEP §706.02(j) specifies that:

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35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The §103 rejection of Claim 49 is presented for the first time in the present Office Action, and fails to comply with any of the four requirements listed above. Instead, the Examiner simply makes a conclusory assertion that the subject matter of Claim 49 would be obvious, and refers to a previous rejection of Claims 38-46. However, as discussed above, most of Claims 38-46 were rejected under §102 and not §103, and in any event none of Claims 38-46 recite the same subject matter as Claim 49. Since the §103 rejection of Claim 49 thus does not comply with any of the requirements for a proper §103 rejection, it is respectfully submitted that it is defective and must be withdrawn.

For completeness, Applicants will briefly explain why Claim 49 is not obvious in view of Breed. (However, this is not a waiver of Applicants' objection to the fact that the §103 rejection of Claim 49 is defective). Claim 49 depends from Claim 42, and includes a recitation that "said second portion emits said wireless signal at a location external to said container". The Office

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Action cites the sentence at lines 41-46 in column 11 of Breed. As noted above, this sentence in Breed states that:

The door status sensor 24 is coupled to the interior sensor system 12, or at least to the transmitters 14,14' so that the transmitters 14,14' can be designed to transmit waves into the interior of the container 10 only when the door status sensor 24 detects when at least one door 18 is closed after having been opened. (Emphasis added).

Contrary to the assertions in the Office Action, this sentence in Breed does not contain anything that even remotely says Breed emits a wireless signal at a location external to the container. MPEP §2142 states with respect to §103 that to "establish a *prima facie* case of obviousness . . . the prior art reference . . . must teach or suggest all the claim limitations". (Emphasis added). Breed fails to satisfy this PTO requirement, because Breed does not teach or suggest all the claim limitations. Therefore, it is respectfully submitted that Claim 49 is not obvious under §103 in view of Breed, and notice to that effect is respectfully requested.

Dependent Claims

Claims 39-41 and Claims 43 and 45-47 respectively depend from Claim 38 and Claim 42, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 38 and 42.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way

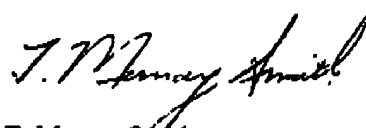
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by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Although Applicants believe that no fee is due in association with the filing of this paper, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Enclosures: None

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